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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,664	12/17/2001	Philip M. Ginsberg	CF-29	1778

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EXAMINER

AKINTOLA, OLABODE

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/022,664	Applicant(s) GINSBERG, PHILIP M.	
	Examiner Olabode Akintola	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/17/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
 4a) Of the above claim(s) 9-36 and 45-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/10/03 & 1/31/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's communication filed on March 9, 2006.
Claims 1-72 pending in the application are subject to restriction/election as discussed below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: Claims 1-8 and 37-44 are drawn to a method and system for selling a durable good futures contract.

Invention II: Claims 9-21 and 45-57 are drawn to a method and system for buying a durable good futures contract.

Invention III: Claims 22-36 and 58-72 are drawn to a method and system for monitoring a durable good futures contract.

3. The inventions I, II and III are distinct, each from the other because of the following reasons:

Inventions I - III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01). In the

instant case, each invention has separate utility such as selling, buying and monitoring. See MPEP § 806.05(d).

After a phone call on July 24, 2006, a provisional election was made by Mr. Joel Weiss (Attorney for the Applicants) to prosecute claims 1-8 and 37-44.

Accordingly claims 9-36 and 45-72 are withdrawn from consideration as being directed to non-elected invention. Applicant is respectfully requested to cancel the withdrawn non-elected claims 9-36 and 45-72 of inventions II and III in response to this office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 and 37-44 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. For an invention to be “useful” it must satisfy the utility requirement of section 101. The official interpretation of the utility requirement provides that the utility of a claimed invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP 2107. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. Statements in the specification describing a practical application may not be sufficient to satisfy the requirements for section 101 with respect to the claimed invention. Apart from the utility requirement of 35 U.S.C. 101, usefulness

under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. The mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore is non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

Independent claims 1 and 37 recite limitations “providing trading interface, receiving goods parameters via interface, constructing future contracts, posting future contracts and determining if a buyer has accepted a contract agreement”. However, these steps do not produce any useful result. Specifically, for the aforementioned steps to be useful, it must satisfy the utility requirement of section 101. It is not clear what useful result the step “determining if a buyer has accepted a contract agreement” produces. Therefore, claimed invention(s) when viewed as a whole fail to produce a useful, concrete and tangible result and therefore is analyzed as non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 37-44 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Particularly in claims 1 and 37, it is not clear how the method achieves selling a durable good as recited in the preamble. Also, the step of determining if a buyer has accepted a futures contract trader agreement is indefinite because the outcome of the determination is not definite.

Claims 2 and 38 recites the limitation “the selling the durable good futures contract”. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 37-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Church (U.S. Patent Application No. 20020049643) (church) in view of Whitworth (U.S. Patent No. 6622129) (Whitworth).

Re claims 1-8 and 37-44: Church teaches a method and corresponding system for selling futures contract comprising: providing a futures market trading interface (section [0032]); receiving durable good parameters through the trading interface from a seller (section [0008]); constructing the durable good futures contract based on the durable good parameters provided by the seller (section [0039]); posting the durable good futures contract (section [0067]); and determining if a buyer has accepted a futures contract trader agreement (section [0067]).

Church does not explicitly teach durable goods selected from the group consisting of an automobile, watercraft, an aircraft and a home appliance. Whitworth teaches automobile and aircraft futures (see col. 5, lines 17-27 and lines 38-40; col. 11, lines 18-21 and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Church to include durable goods as taught by Whitworth. One would have been motivated to do this in order to create an exchange-traded futures based on basket of manufactured goods (col. 4, lines 38-39).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



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